UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/475,912	12/30/1999	PERRY A. PIERCE	E-925	7042

919 7590 03/22/2004	EXAMINER	
PITNEY BOWES INC.	ZURITA, JAMES H	
35 WATERVIEW DRIVE		
P.O. BOX 3000	ART UNIT	PAPER NUMBER
MSC 26-22	3625	
SHELTON, CT 06484-8000		

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _28 November 2003_.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,3-7,9-17 and 19-24_ is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1, 3-7, 9-17, 19-24_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　　1.☐ Certified copies of the priority documents have been received.

　　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant amended claims 1, 9, 14, 15, 17 and 19.

Claims 1, 3-7, 9-17 and 19-24 are pending and will be examined.

Response to Arguments

Applicant's arguments filed 28 November 2003 have been fully considered but

they are not persuasive.

Applicant argues that Ginter does not disclose or anticipate applicant's new

limitations to claims 1 and 17, introduced by applicant's amendment. In response to

these arguments, please see rejections below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or
composition of matter, or any new and useful improvement thereof, may obtain a patent
therefor, subject to the conditions and requirements of this title.

Claims 1 and 17 are rejected under 35 U.S.C. 101 because the disclosed

invention is inoperative and therefore lacks utility.

As per Claim 1, the system is incapable of doing any work, since there no

processor to run the claimed program.

As per claims 1 and 17, Applicant refers to digital signatures as being used to

verify authenticity and as being available though a Certification Authority. The functions

that applicant ascribes to digital signatures are functions that are carried out by digital

certificates. Applicant does not disclose digital certificates. For example:

- Preferably, the method further includes the step of providing a *digital signature* to the buyer so as to allow the buyer to verify the authenticity of the downloaded data item through a *Certification authority*. (Page 4, lines 22-24)

- Preferably, a *digital signature* of the seller is also stored in the identification code storage area 312 so that the *digital signature* can be provided to the buyer when the buyer downloads the data item. With the *digital signature*, the buyer can verify the authenticity of the downloaded data item. Similarly, a buyer may use his/her password to access the associated vault to check the balance. (Page 8, line 222-26)

- Preferably, the data repository system 100 is connected to a telecommunication network 120, such as the Internet, so as to allow the users (11 16) to access the data repository system 100 through the telecommunication network 120. Preferably, a *Certification authority* 140 is also connected through the telecommunication network 120 so as to allow the buyer to verify the authenticity of the downloaded data items. Preferably, the *Certification authority* 140 is provided by a third party who is independent of the users (11-16) and the data repository system 100. (Page 6, line 25-page 7, line 4)

A *digital signature* is a security mechanism used on the Internet that relies on

two keys, one public and one private, that are used to encrypt messages before

transmission and to decrypt them on receipt.[1]

A *digital certificate* is an assurance that software downloaded from the Internet

comes from a reputable source. A digital certificate provides in formation about the

software – such as the identity of the author, and the date on which the software was

registered with a certificate authority.[2]

A *certification authority* is an issuer of digital certificates, the cyberspace

equivalent of identify cards. A certificate authority may be an external issuing company,

such as VeriSign) or an internal company authority that has installed its own server

(such as the Microsoft Certificate Server) for issuing and verifying certificates.[3]

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[1] Definition of *digital signature*, MICROSOFT Computer Dictionary.
[2] Definition of *digital certificate*, MICROSOFT Computer Dictionary.
[3] Definition of *certification authority*, MICROSOFT Computer Dictionary.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 17 and claims dependent thereon are rejected under 35 U.S.C. 112,

first paragraph, as failing to comply with the written description requirement. The

claim(s) contains subject matter which was not described in the specification in such a

way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the

time the application was filed, had possession of the claimed invention.

Amended claim 1 contains the limitation

(viii)   to provide a digital signature to the buyer to allow the buyer to verify the authenticity of the downloaded data item through a certification authority.

Amended claim 17 contains the limitation

a) providing a digital signature to the buyer to allow the buyer to verify the authenticity of the downloaded data item through a certification authority.

The functions that applicant attributes to digital signatures, such as verifying

authenticity, are functions that are carried out by the use of digital certificates, which are

not disclosed by applicant. See definitions of digital signature, digital certificate and

certification authority, above.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 17 and claims dependent thereupon are rejected under 35 U.S.C. 112,

second paragraph, as being indefinite for failing to particularly point out and distinctly

claim the subject matter which applicant regards as the invention. The claims refer to

providing a digital signature to a buyer to allow the buyer to verify the authenticity of the

downloaded data item through a certification authority. See definitions of digital

signature, digital certificate and certification authority, above.

Where applicant acts as his or her own lexicographer to specifically define a term

of a claim contrary to its ordinary meaning, the written description must clearly redefine

the claim term and set forth the uncommon definition so as to put one reasonably skilled

in the art on notice that the applicant intended to so redefine that claim term. *Process*

Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed.

Cir. 1999). The term "digital signature" in claims 1 and 17 is used by the claim to mean

"digital certificate", while the accepted meaning is "...a security mechanism used on the

Internet that relies on two keys, one public and one private, that are used to encrypt

messages before transmission and to decrypt them on receipt."[4] The term is indefinite

because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

Claims 1, 3-7, 9-17 and 19-24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Ginter et al. (US Patent 5,892,900).

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[4] Definition of *digital signature*, MICROSOFT Computer Dictionary. See above.

The Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Ginter discloses applicant's claimed methods and systems, including:

(a) **Storing data items and excerpts of data items** in a data repository. See for example, at least references to secondary storage, secure databases, other information, Fig. 8 and related text, at least Col. 62, line 51-Col. 64, line 15.

(b) **Depositing a fund** in the data repository, deducting a monetary sum from the fund, crediting the deducted money sum to a seller. See, for example, references to funds transfer system which resolves payments through buyer/seller debits/credits and processes direct debits to bank accounts, at least Col. 316, line 53-Col. 317, line 14.

(c) **Downloading a portion of the data item** so that a buyer may review a portion of the data item without the possibility of downloading the entire data item without paying the seller. See, for example, at least Fig. 56 and related text. See **also [1203]**

(d) **Downloading data items** from the data repository. See, for example, access, Fig. 54 and related text, at least Col. 198, line 41-Col. 200, line 53.

(e) **Deducting a monetary sum from the fund and** crediting the deducted monetary sum to a seller. See, for example, at least references to funds transfer

system which resolves payments though debits and credits of buyer and sellers and also processes direct debits to bank accounts, Col. 316, lines 53-Col. 317, line 14.

Comparing offered price to a price range, to determine if the offered price falls within a range specified by a seller. A buyer is allowed to download the data item if the buyer's proposed monetary sum for downloading the item is greater than or equal to a minimum amount. See, for example, at least Col. 269, line 15-Col. 278, line 37. See also references to software that automatically compares a buyer's price to determine if the amount is within a range described as acceptable, at least Col. 278, lines 6-37.

(f)   Encrypting a data item prior to downloading the data item to the buyer. See at least Col. 127 line 56 to Col. 128 line 3, Col. 174 line 1 to 22, Col. 209 line 3 to 23, Col. 221 line 53 to 67, Col. 223 line 28 to 44, Col. 229 line 14 to 30, Col. 234 line 55 to Col. 235 line 13, Col. 253 line 8 to 65, Col. 338 line 11 to 28.

Ginter provides **digital signatures** to buyers. For example, see references to encryption and public keys provided to buyers, at least in Col. 7 line 58 to Col. 8 line 7, Col. 21 line 40 to 59, Col. 29 line 19 to Col. 30 line 39, Col. 146 line 54 to Col. 147 line 4, Col. 203 line 29 to 45, Col. 210 line 49 to 58, Col. 226 line 21 to 38, Col. 234 line 55 to Col. 235 line 13, Col. 239 line 15 to 25, Col. 257 line 8 to Col. 258 line 3, Col. 261 line 10 to 48, Col. 270 line 66 to Col. 271 line 36, Col. 272 line 62 to Col. 274 line 17, Col. 299 line 8 to 59.

(g)   Providing digital certificates and certification authority. See, for example, at least Col. 211 line 39 to 67, Col. 219 line 21 to 31, Col. 225, line 58-Col. 227 line 42, Col. 261 line 10 to 48, Col. 273, line 40-Col. 274, line 51.

Ginter also discloses storing account information, including information concerning owners/providers/ marketers (applicant's sellers) and users (applicant's buyers). See for example, at least Col. 14 line 49-Col. 15 line 9, Col. 29 line 29- Col. 30 line 39, Col. 84 line 6-51, Col. 187 line 11-28, Col. 263 line 11-25, Col. 291 line 49- Col. 293 line 49, Col. 315 line 25- Col. 317 line 42, Col. 329 line 11-45, Col. 335 line 31-52

As per claims 1-16, Ginter **does not** use applicant's labels to refer to various areas of storage, including 'data repository' and 'data storage' and 'monetary storage' and 'information storage.' The Examiner finds the various labels to be nonfunctional descriptive material that carries little patentable weight and carry little patentable weight, since the claim language does not describe what is relevant about the labels attached to each storage area and the labels by themselves provide no patentable distinction to the storage areas. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any data in the fields of the system disclosed by Ginter because such data does not functionally relate to the system and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

As per claims 1-16, Ginter **does not** specifically disclose applicant's claimed system limitations such as

1. (currently amended) [preamble] ... to allow a seller to store a data item that the seller
wishes to sell electronically to a buyer for a fee,...
"(ii)   ...for posting the fee for downloading the data item from the data storage, and
the buyer deposits the fund in the monetary storage prior to downloading the data item",
           "capable of ...so as to store a fund deposited by the buyer to pay for
downloading the data item into the buyer's account"
"(iii)   to allow the buyer to ...so that the buyer may review the data item without the
possibility of downloading the data item in its entirety without paying the seller"
"(v)   to allow the buyer to ...from the data storage..."
",,, wherein the fee for downloading the data item has a range specified by the Seller and
defined by a maximum amount, and a minimum amount wherein the maximum amount is
the fee posted by the Seller, and a minimum amount is what the Seller is willing to collect
from the buyer for downloading the data item so that the buyer is allowed to download the
data item if the buyer's proposed monetary sum for downloading the data item is greater
or equal to the minimum amount specified by the seller and after the buyer's proposed
monetary sum is deducted from the buyer's account and credited to the seller's
account..."
"...to prevent an unauthorized person from obtaining the downloaded data item by
interception
"(viii)   ... to allow the buyer to verify the authenticity of the downloaded data item
through a certification authority..."

The Examiner notes that the cited language is nonfunctional descriptive material.

When examining the claims as a whole, the nonfunctional descriptive material carries

little patentable weight and the specific meaning/interpretation of the data stored in the

various storage areas does not patentably distinguish the claimed system.

Further, the recited statements of intended use "...for posting..." "...to allow a

buyer/seller to ...", etc., do not patentably distinguish the claimed system. It would have

been obvious to one of ordinary skill in the art at the time the invention was made to

provide any type of data for various purposes in the system taught by Ginter because

the subjective interpretation of the data does not patentably distinguish the claimed

invention.

As per Claims 17 and 19-24, the Examiner respectfully notes that the language

e) ... a range specified by the Seller and defined by a maximum amount, and a minimum
amount wherein the maximum amount is the fee posted by the Seller, and a minimum
amount is what the Seller is willing to collect from the buyer for downloading the data item
so that the buyer is allowed to download the data item if the buyer's proposed monetary

sum for downloading the data item is greater or equal to the minimum amount specified
by the seller

is nonfunctional descriptive material. The cited language (a) merely describes

inferential activities that are not involved in an active sense (b) is not considered part of

the actual method of claim 17 since the language describes precursor steps to claim 17,

(c) has no effect on the method itself, and (d) falls outside the metes and bounds of

claim 17. The descriptive material imparts little patentable moment in distinguishing the

instant method from that of the prior art.

As per Claims 17 and 19-24, directed to methods, Ginter *does not* specifically

disclose applicant's claimed method limitations, including

[preamble] 17. (currently amended) ... of providing a service by a service provider to
allow a seller to electronically sell a data item for a fee to a buyer who downloads the
data item through a telecommunication network...:

c) ... so that the buyer may review a portion of the data item without the possibility of
downloading the entire data item without paying the seller;
e) ... from the fund and ..., wherein the fee for downloading the data item in its entirety
has a range specified by the Seller and defined by a maximum amount, and a minimum
amount wherein the maximum amount is the fee posted by the Seller, and a minimum
amount is what the Seller is willing to collect from the buyer for downloading the data item
so that the buyer is allowed to download the data item if the buyer's proposed monetary
sum for downloading the data item is greater or equal to the minimum amount specified
by the seller
f) ... prior to downloading the data item to the buyer to prevent an unauthorized person
from obtaining the downloaded data item by interception; and
g) ... to the buyer to allow the buyer to verify the authenticity of the downloaded data item
through a certification authority...

However these differences are only found in the nonfunctional descriptive

material and are not functionally involved in the steps recited. The steps of (a) storing

(b) depositing a fund (c) downloading a portion of the data item (d) downloading the

data item from the (data) repository (e) deducting a monetary sum (f) crediting the

deducted sum to the seller (g) encrvptinq the data item and (h) providing a digital

signature would be performed the same regardless of the data.   Thus, this descriptive

material will not distinguish the claimed invention from the prior art in terms of

patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir.

1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to disclose

> [preamble] 17. (currently amended) ... of providing a service by a service provider to
> allow a seller to electronically sell a data item for a fee to a buyer who downloads the
> data item through a telecommunication network...:
>
> c) ... so that the buyer may review a portion of the data item without the possibility of
> downloading the entire data item without paying the seller;
> e) ... from the fund and ..., wherein the fee for downloading the data item in its entirety
> has a range specified by the Seller and defined by a maximum amount, and a minimum
> amount wherein the maximum amount is the fee posted by the Seller, and a minimum
> amount is what the Seller is willing to collect from the buyer for downloading the data item
> so that the buyer is allowed to download the data item if the buyer's proposed monetary
> sum for downloading the data item is greater or equal to the minimum amount specified
> by the seller
> f) ... prior to downloading the data item to the buyer to prevent an unauthorized person
> from obtaining the downloaded data item by interception; and
> g) ... to the buyer to allow the buyer to verify the authenticity of the downloaded data item
> through a certification authority...

because such data does not functionally relate to the steps in the method claimed and

because the subjective interpretation of the data does not patentably distinguish the

claimed invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Zurita
Patent Examiner
Art Unit 3625
12 March 2004

Jeffrey A. Smith
Primary Examiner